REMARKS

On September 11, 2000, Appellants filed a pending patent application along with Claims 1-19. On March 3, 2003, the Examiner issued a first Office Action rejecting Claims 1-19. On May 28, 2003, Appellants filed an amendment and response in which Claims 1, 3-6, 8, 10, 14, and 19 were amended; and Claims 2 and 9 were canceled. On August 12, 2003, the Examiner issued a second Office Action, finally rejecting Claims 1, 3-8, and 10-19. More specifically, in the final Office Action of August 12, 2003, the Examiner rejected Claims 1, 3, and 19 under 35 U.S.C. § 102(b) as being anticipated in view of the teachings of U.S. Patent No. 5,537,315, issued to Mitcham (hereinafter "Mitcham"). In addition, the Examiner rejected Claims 4-8 and 10-19 under 35 U.S.C. § 103(a) as being unpatentable in view of the teachings of Mitcham, taken in view of the teachings of the CNA Customer Services State Sales Offices Web site, *<http://web.archive.org/web/20000311214508/www.cna.com/group/custserv/gr_stat.html>* (hereinafter "CNA Reference"), and further in view of the teachings of the MostChoice Advisor Web site, *<http://web.archive.org/web/20000818065246/www.mostchoice.com/General /Advisor_Center/Why/G_Adv_Why_Overview.cfm>* (hereinafter "MostChoice reference"). An appeal followed on November 4, 2003, in which Appellants entreat the Board to reverse the final rejections of Claims 1, 3-8, and 10-19. This Request for Continued Examination follows to reopen prosecution to address issues raised in the Examiner's Answer that have not been adequately covered.

Prior to discussing in detail why applicants believe that the pending claims in this application are allowable, a brief description of applicants' invention and a brief description of the teachings of the cited and applied references are provided. The following background and the discussions of the disclosed embodiments of applicants' invention and the teachings in the cited and applied references are not provided to define the scope or interpretation of any of the

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claims of this application. Instead, such discussions are provided to help the United States Patent and Trademark Office (hereinafter "the Office") better appreciate important claim distinctions discussed thereafter.

Background of the Invention

Web sites are now available that provide insurance services, such as premium quotations, for an insurance policy. Traditionally, insurance policies have been sold through insurance agents. These agents may be employed by an insurance company, or they may operate independently. Insurance companies have typically relied on insurance agents to be a first point of contact with customers and to provide extra value to the insurance policies provided by the insurance companies. Many Internet Web sites that provide insurance products have supplanted these insurance agents so as to sell insurance policies directly to the consumer. In some cases, these Web sites may pay a commission to an agent for the sale, but the insurance companies that operate such sites retain control over the customer's account and do not release this control to the selling agent.

Paying insurance agents a commission for an on-line sale of an insurance policy without releasing control of the customer's account to the agent is a myopic business strategy for an insurance company. In the long term, this strategy may have many drawbacks. For instance, customers may not receive the level of personalized service and value they once received because insurance agents may be unmotivated to provide additional service (if they will not receive monetary compensation). For these and other reasons, selling insurance policies directly to consumers through an Internet Web site without completely re-intermediating the insurance agent by providing complete control of the customer to the agent may not be a desired business model.

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Summary of the Invention

Appellants' invention is directed to avoid or reduce the above problems by providing a method and system for providing insurance policies via a distributed computing network that receives a request from a customer to purchase an insurance policy according to a bindable insurance premium quotation, and in response to such a request, re-intermediating an insurance agent and issuing the insurance policy. The prospective customer may purchase the insurance policy according to a provided bindable premium quotation through a Web site. If the prospective customer elects to purchase the policy, the Web site may re-intermediate an insurance agent into the sales process. The insurance agent may be re-intermediated by first providing a list of available insurance agents to the prospective customer. The prospective customer may select one of the insurance agents from the list. Once an agent has been selected, complete control of the customer's account is transferred from the Web site to the selected agent. To accomplish this, information regarding the prospective customer and the insurance policy is transmitted to the insurance agent. Using this information, the insurance agent may make direct contact with the customer and provide value-added services to the customer. Additionally, the insurance agent receives a commission for his services.

The list of insurance agents provided to the prospective customer may be compiled based on the geographical distance between the agents and the customer. For instance, the insurance agents closest to the purchaser's home may be identified and displayed. Similarly, the customer may indicate that the insurance agent geographically closest to his address should be assigned to service the policy. Once an insurance agent has been re-intermediated in this manner, the insurance policy and any accompanying documents may be delivered to the customer in electronic form.

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Summary of Mitcham.

Similar to the example described in the background of Appellants' invention, the system of Mitcham is directed to a system allowing a user to independently create a binding insurance agreement. See Col. 4, lines 9-12. But the similarity ends there. Mitcham indicates that such creation of the binding insurance agreement occurs "without the need for interacting with a representative of an insurance company" (emphasis provided). See Col. 4, lines 10-11. The system of Mitcham, through a kiosk, prompts the user to enter required information in order to calculate an insurance rate. Once this information has been entered, a rate may be calculated for differing levels of coverage. Insurance companies may supply rates to the kiosk. A determination is made of the identity of the company providing the lowest rate for a particular level of coverage. A user may then receive a binder upon the selection of a particular level of coverage if the user elects to pay for the insurance with a credit card. A signature screen is then displayed. The user may then sign the screen using any type of pointing device. The distinguishing difference between the system of Mitcham and the present invention is the lack of receiving a request to purchase an insurance policy according to a bindable insurance premium quotation, and in response to the request, re-intermediating an insurance agent and issuing the insurance policy.

As described by Mitcham at FIGURE 3C, after the user has entered various personal information, the system of Mitcham determines the lowest rate for each level of insurance coverage for the user. For example, the minimum level of coverage may include only those levels required by a particular state. Next, the system of Mitcham determines the identity of the insurance company providing the lowest rate for levels of coverage. The company name and the associated rate are then stored. If the insurance company does not want its name to be displayed on the kiosk, only the coverage limit and rate for each level of coverage are displayed.

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Otherwise, the coverage limit, rate for each level, as well as the name of the insurance company, are displayed on the kiosk. Next, the system of Mitcham allows the user to select the level of coverage that the user desires. Once a level of coverage is selected, the system of Mitcham displays various options. See Col. 6, lines 20-25.

FIGURE 3D of Mitcham illustrates the logic of the options presented to the user. Four options are available to the user. First, the user can opt to complete the contract (in other words, to request to purchase an insurance policy). Second, the user can elect to have a representative of an insurance company contact the user. (Note that this is a complete departure from the teachings of the present invention, where the insurance agent is re-intermediated when the user decides to purchase an insurance policy. In other words, the logic of completing the contract in the system of Mitcham is separated from the logic of electing to have a representative of the insurance company contact the user.) Third, the user can select the printing of an insurance quote. Fourth, the user may decide to exit from the on-line insurance purchase process. FIGURE 3D of Mitcham crystallizes the distinguishing difference between the claimed invention and the system of Mitcham. The logic path of the option to complete the insurance contract is completely separate from the logic path in which the user is requesting a representative of an insurance company to contact the user.

Summary of the CNA Reference.

On page 13, the CNA reference describes that insurance is sold through independent agents and brokers across America, whose Web sites can be found on an agent locator page. To locate a CNA branch office, according to page 11 of the CNA reference, a map is used by a user to locate a particular state from which the address of local CNA sales offices will then be displayed to the user. Unlike the present invention, no method of providing an insurance policy via a distributed computing network is taught or even suggested by the CNA reference.

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There can be no re-intermediation in the system described by the CNA reference because the user must first track down a CNA insurance agent before the CNA insurance agent can help the user obtain an insurance policy. The system of the CNA reference is no different than the traditional approach of looking up an insurance agent in the yellow pages and calling the insurance agent.

Summary of the MostChoice Reference

The MostChoice reference is a collection of Web pages of a Web site allowing a user to apply for an insurance policy or talk to "local advisors" regarding the insurance policy. Page 1 of the reference illustrates a table with two columns. The first column is described by the MostChoice reference as the offerings of independent insurance agents. In the second column of the table, the MostChoice reference distinguishes the offerings of independent insurance agents from "local advisors," who provide more services than those of independent insurance agents.

On page 1 of the MostChoice Reference, the following is discussed:

> You can see that using a local advisor makes a lot of sense, and in fact that some of our on-line only competitors are misleading you by implying that it is cheaper and easier to do it all yourself online. Hey, but then again you don't have to use an advisor at all if it bothers you! You can apply online with us and barely talk to anyone at all during the process. (Emphasis provided.)

Through Appellants' attorneys, an attempt was made to apply for an insurance quote on-line at the Web site "*www.mostchoice.com*" archived at the Web site "*web.archive.org.*" Instead of receiving a Web page for filling out information to obtain an insurance quote, Appellants received a Web page displaying the text "Under Construction." One of the reasons that the MostChoice reference is not enabling (and therefore cannot teach or suggest the claimed invention) is because a user could not use the MostChoice reference to apply for a bindable insurance policy at the time the claimed invention was made. The Web page of the MostChoice

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reference that would have allowed only a quote was still "under construction." Thus, it simply cannot be possible for the MostChoice reference to receive a request to purchase an insurance policy according to a bindable insurance premium quotation, and in response to the request, re-intermediating an insurance agent and issuing the insurance policy. The present-day Web site "*www.mostchoice.com*" continues to not allow anyone to purchase an insurance policy according to a bindable insurance premium quotation, and in response to the request, re-intermediating an insurance agent and issuing the insurance policy. No re-intermediating process is taught or suggested by the MostChoice reference. Users would have to connect to the local advisors first, similar to the process described by the CNA reference.

The Claims Distinguished

As will be discussed below, the Examiner has failed to establish a *prima facie* case of anticipation and obviousness. To establish *prima facie* anticipation of a claimed invention, each and every element as set forth in the claimed invention must be found in a single prior art reference. See M.P.E.P. § 2131. Moreover, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art, as indicated by M.P.E.P. § 2143.03. The cited and applied references do not teach, on the one hand, the concept of receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy, or, on the other hand, the concept of transmitting an electronic version of said insurance policy to an individual insured by the said insurance policy. Moreover, a number of cited and applied references cannot be combined, such as Mitcham, the CNA reference, and the MostChoice reference, without destroying the operation of all references.

As discussed in greater detail below, the claims of the present application are clearly patentably distinguishable over the teachings of the above-cited references. The present

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invention is directed to avoid or reduce the impersonal aspects of on-line sales of insurance policies, because of which customers may not receive the level of personalized service and value they once received from insurance agents. This is accomplished by a system and method for providing insurance policies via a distributed computing network that re-intermediates insurance agents into the on-line policy sales process. The prospective customer may purchase the insurance policy according to a provided bindable premium quotation through a Web site. If the prospective customer elects to purchase the policy, the Web site may re-intermediate an insurance agent into the sales process. The insurance agent may be re-intermediated by first providing a list of available insurance agents to the prospective customer. Once an agent has been selected, complete control of a customer's account is transferred from the Web site to the selected agent. To accomplish this, electronic information regarding the prospective customer and the insurance policy is transmitted to the insurance agent. Using this information, the insurance agent may make direct contact with a customer and provide value-added services to the customer. Additionally, the insurance agent receives a commission for his services.

As noted above, the Examiner rejected Claims 1, 3-8, and 10-19 under 35 U.S.C. §§ 102(b) and 103(a) as being unpatentable in view of the teachings of the three references described above, alone much less in combination. As also noted above, Appellants respectfully disagree. The cited and applied references simply fail to teach all of the claim limitations of the independent claims, much less the recitations of many of the dependent claims. These claims particularly point out and distinctly claim subject matter that Appellants regard as their invention and that is clearly patentably distinguishable from the cited and applied references.

The Office has failed to show, and applicants are unable to find, where any of the cited and applied references, either alone or in combination, disclose the subject matter of the claimed invention. Among other differences, none of the applied and cited references teaches "receiving

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a request to purchase said insurance policy according to said bindable insurance premium quotation; and in response to said request, re-intermediating an insurance agent and issuing said insurance policy," as recited in amended independent Claims 1, 8, and 19.

The system of Mitcham, through a kiosk, executes a program that prompts the user to enter required information in order to calculate an insurance rate. Among a variety of screens, one screen provides options for completing an application, having a representative of an insurance company contact the user, printing a quote of the selected level of coverage, or exiting the program. See Mitcham at Col. 6, lines 20-25. The Examiner has incorrectly insisted that this portion of Mitcham provides the necessary teaching to anticipate Appellants' claimed invention. To understand this portion of Mitcham, it is necessary to understand the appropriate section of the program executed by the system of Mitcham.

The above-described options are displayed to the user by the execution of block 248. See Mitcham at Figure 3C. From block 248, the program of Mitcham enters a continuation terminal ("terminal C"). From terminal C (Figure 3D of Mitcham), the program proceeds to decision block 250 where a test is made to determine whether the user has decided to complete the insurance contract. If the answer is YES to the test at decision block 250, the program of Mitcham proceeds to another continuation terminal ("terminal D"). Otherwise, the answer is NO to the test at decision block 250, and the program of Mitcham continues to decision block 318 where another test is made to determine whether the user desires contact by a representative of an insurance company. If the answer is YES to the test at decision block 318, the user enters name, address, and telephone number. See block 322 of Mitcham. At block 324, the program of Mitcham transmits user information to the insurance company using various communication means. The program then proceeds to other decision blocks as shown in Figure 3D.

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If what has been described in the above paragraph is still unclear, Appellants will spell out the essential difference between Appellants' claimed invention and the system of Mitcham: if the user decides to complete the insurance contract, the program of Mitcham leads a user to terminal D to access portions of the program of Mitcham to complete the insurance contract. See Figures 3E-3G. If the user decides otherwise, the user may then select the option of allowing a representative of an insurance company to contact the user. If somehow this essential difference is still not apparent, here is more: After the program of Mitcham has entered terminal D to execute portions of the program of Mitcham to complete the insurance contract, the program of Mitcham enters an exit terminal ("terminal H"). See Figure 3G. From the exit terminal H (Figure 3D), the program of Mitcham loops back to decision block 318, among other decision blocks, allowing the user to select the option, among other options, for a representative of an insurance company to contact the user. Note that this option to contact occurs well after the completion of the insurance contract by the looping of the program to decision block 318 from the exit terminal H. Thus, the system of Mitcham fails to provide the feature of "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy" as recited in Claims 1, 8, and 19.

In the Examiner's Answer, the Examiner argued that it is terminal E that causes the program of Mitcham to exit and not terminal H. Therefore, because of this reason, according to the Examiner, the option to contact does not occur "well after the completion of the insurance contract" but rather is an integral part of Mitcham's invention. See page 15 of the Examiner's Answer. This argument by the Examiner is unnecessarily obscuring what Mitcham actually teaches. There is nothing in the applicant's explanation of the program flow at FIGURES 3D-3G that could possibly lead the Examiner to that questionable conclusion. Applicants have couched

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terminal H as an exit terminal to show the egress of the program flow from the process diagrams illustrated in FIGURES 3E-3G of Mitcham. As explained by the applicants, from the terminal H (originating from FIGURE 3G and terminating at FIGURE 3D) the program of Mitcham loops back to decision block 318, among other decision blocks, allowing the user to select the option, among other options, for a representative of an insurance company to contact the user. Applicant emphasizes that this option to contact occurs well after the completion of the insurance contract by the looping of the program to decision block 318 from the terminal H. There can be no argument to the contrary because this is not a matter of ambiguous interpretation but a matter of simply looking at FIGURE 3G, which shows the program flow entering terminal H and looping back to the decision block 318 at FIGURE 3D. Thus, the system of Mitcham fails to provide the feature of "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy" as recited in Claims 1, 8, and 19.

To continue with the unnecessary obfuscation, the Examiner then cites Col. 6, lines 19-24, of Mitcham for the ridiculous proposition that Mitcham teaches the claimed feature of "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy." No obfuscation can hide the truth. That portion of Mitcham is describing block 248 of Mitcham, which applicants have already explained above. The execution of block 248 occurs before the program flow enters terminal C. See FIGURE 3C of Mitcham. Block 248 in essence is describing a presentation of a user interface in which there are a number of choices that are available to a user to make. Here is the actual recitation of the portion of Mitcham at Col, 6, lines 19-24:

> Next, the process passes to block 248 which illustrates the displaying of options. The options may include completing an application, having a representative of the company contact the

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user, printing a quote of the selected level of coverage, or exiting the program. (Emphasis provided.)

The term "or" in the above quote indicates that there is a choice to be made, but only one choice. This is clarified by looking at the next figure of Mitcham, FIGURE 3D. There are four decision blocks that implement the user interface of block 248 in FIGURE 3C. The four decision blocks force the user to select a single choice but not two choices at once. If this is somehow not clear, applicants would like to emphasize the following point: Assume momentarily for the sake of argument that the choice of completing an application and the choice of having a representative of the company contact the user can be integrally made as argued by the Examiner. If this is the case, then there is nothing to stop the silly conclusion of having the simultaneous choice of completing an application at the same time as exiting the program. This silly conclusion is as illogical as the Examiner's proposition to force the choice of completing an application to be somehow contemporaneously made with the choice of having a representative of the company contact the user.

The main problem with the system of Mitcham is that it completely lacks the feature of "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy" as recited in Claims 1, 8, and 19. In contrast, the system of Mitcham either allows the user to complete the insurance contract or have a representative of an insurance company contact the user—but not "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy" as recited in Claims 1, 8, and 19.

The Examiner has argued that Mitcham already teaches the concept of re-intermediating at FIGURE 13 of Mitcham: "[n]o sales call will be made without your request. To purchase

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your policy, please contact [a representative of an insurance company] at [a shown phone number]." See the August 12, 2003, final Office Action. To fully and fairly understand what Mitcham actually teaches, Appellants have set forth in full the cited portion of Mitcham:

> No policy has been issued; this is an informational quotation only. Changes in coverage will affect this proposal and premium amounts quoted. No sales call will be made without your request. To purchase your policy, please contact AUTOSURE at (214) 325-3001. (Emphasis provided.)

See FIGURE 13 of Mitcham.

It is not clear why the above-cited portion of Mitcham was not originally revealed in full. This portion of Mitcham teaches completely opposite from Appellants' claimed invention. For example, one feature of the claimed invention is "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy" as recited in Claims 1, 8, and 19. No bindable insurance premium quotation is provided by Mitcham at FIGURE 13. As clearly stated by Mitcham, the quotation provided by Mitcham is "an informational quotation only." Moreover, FIGURE 13 illustrates a screen displayed by the program of Mitcham after the execution of block 246. See Mitcham at Col. 6, lines 16-20. The execution of block 246 occurs before block 248 and before other portions of the program of Mitcham to complete an insurance contract.

As specified by M.P.E.P. § 2131.01, "The identical invention must be shown in as complete detail as is contained in the . . . claim," citing favorably *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis provided). Because the Examiner has failed to show that Mitcham discloses the identical invention as

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claimed in the pending application, accordingly, no *prima facie* case of anticipation has been established by the Examiner.

In response to this legal precedent from the Federal Circuit, the Examiner has argued that the identical invention need not be taught but that to anticipate a claim, the reference must teach every element of the claim. See page 18 of the Examiner's Answer. This sort of argument reveals a complete misunderstanding of legal precedent under 35 U.S.C. § 102. Applicants point out that every element of the claimed invention must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) citing *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 895, 221 USPQ 669, 673; *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771-72, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026, 79 L. Ed. 2d 687, 104 S. Ct. 1284 (1984). Moreover, the identical invention must be shown in as complete detail as is contained in the patent claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920.

The Examiner argues that the reference Mitcham need not teach every element of the claimed invention, arranged as in the claims. That is wrong. The Examiner also has proposed that the reference Mitcham need not disclose the identical invention. That is also wrong. There is no legal precedent to support the Examiner's position. Applicants respectfully request the Examiner refrain from further citing case law, such as *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 2 U.S.P.Q.2D (BNA) 1051, to support Examiner's position that it is not necessary to teach every element of the claimed invention, arranged as in the claims, or that it is not necessary to teach the identical invention. The portion of *Verdegaal Bros., Inc. v. Union Oil Co.*, cited so favorably by the Examiner references *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 U.S.P.Q 781, 789 (Fed. Cir. 1983), which requires that a party asserting that a patent

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claim is anticipated under 35 USC § 102 must demonstrate, among other things, identity of invention.

Applicants have indicated that one feature of the claimed invention is "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy" as recited in Claims 1, 8, and 19. The system of Mitcham neither teaches the identical invention nor does the system of Mitcham teach every element of the claimed invention because Mitcham fails to teach the feature arranged as in the claim. The system of Mitcham either allows the user to complete the insurance contract or have a representative of an insurance company contact the user—but not "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy" as recited in Claims 1, 8, and 19. Thus, there can be no *prima facie* case of anticipation established by the Examiner.

As discussed above, Mitcham has failed to teach "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy" among others, as recited in Claims 1, 8, and 19. The user cannot request to purchase an insurance policy according to a bindable insurance premium quotation through the Web site described by the CNA reference. There can be no re-intermediation in the system described by the CNA reference because the user must first track down a CNA insurance agent before the CNA insurance agent can help the user obtain an insurance policy. Like the CNA reference, the MostChoice reference does not even work to allow a user to obtain a quote on-line, let alone a bindable insurance premium quotation.

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Given the defects of Mitcham, the CNA reference, and the MostChoice reference, there is simply no benefit to combine these references. Even if somehow these references were combinable, whose combination Appellants specifically deny, they cannot teach the claimed invention. Moreover, the defects of the CNA reference cannot cure the defects of Mitcham and the defects of the MostChoice reference cannot cure the defects of the CNA reference or the defects of Mitcham. Whereas the CNA reference requires the user to first track down an insurance agent, Mitcham requires the user to enter various information through a kiosk to obtain an insurance policy "without the need for interacting with a representative of an insurance company." See Mitcham at Col. 4, lines 10-11. The MostChoice reference does not even allow the user to apply for an insurance quote, let alone a bindable insurance policy. Accordingly, the Examiner has not established a *prima facie* case of obviousness.

Appellants have pointed out the following: The Examiner has argued that the system of Mitcham teaches the claimed invention at FIGURE 13, lines 32-34. This cannot be correct. FIGURE 13 as described by Mitcham is a pictorial representation of a computer display screen depicting the lowest rates for each level of coverage and including a summary of data entered by the user. An insurance company name may be displayed as shown in FIGURE 13. But this cannot be confused with re-intermediating an insurance agent upon a request to purchase an insurance policy. There is no request to purchase an insurance policy that a user can select at FIGURE 13 of Mitcham. Moreover, what can be displayed is the name of the insurance company that provides the rate, not an insurance agent who can be re-intermediated.

Appellants have also pointed out the following: The Examiner has also pointed out FIGURE 14A of Mitcham as teaching the claimed invention. FIGURE 14A of Mitcham illustrates a screen allowing a user to sign for insurance coverage. FIGURE 14A occurs after the execution of block 288. See FIGURE 3F of Mitcham. Block 288 belongs to portions of a

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program that gets executed when the user elects to complete the insurance contract whose logic is completely and distinctly separated from the logic of having a representative of an insurance company contact the user. See FIGURE 3D, more specifically, decision blocks 250, 318. Thus, there is nothing about FIGURE 14A that teaches the claimed invention of the Appellants.

Appellants have further pointed out the following: The Examiner has also argued that the system of Mitcham teaches the re-intermediating feature of the claimed invention at Col. 1, lines 64-67. This also cannot be correct. What is disclosed at this portion of Mitcham is that "it is known in the insurance industry for a representative of an insurance company to create an insurance agreement or policy based on information obtained from a prospective insured." There is absolutely no teaching that an insurance agent is re-intermediated upon receiving a request to purchase an insurance policy according to a bindable insurance premium quotation made via a distributed computing network. What is described at that portion of Mitcham is the traditional process for creating an insurance agreement before the advent of providing an insurance policy via a distributed computing network.

Appellants have yet further pointed out the following: The Examiner has further argued that the system of Mitcham teaches the re-intermediating feature of the claimed invention at Col. 2, lines 2-14. This cannot be correct. Mitcham discusses the portion as follows:

> Once the prospective insured pays the company, the company issues a binder. The binder is evidence of the insurance policy. The insurance policy is then sent to the insured at a later time period. The insured is covered by the insurance at the selected level as of the time the binder is issued.

It is difficult to understand what could be taught or suggested by the above text for the Examiner's interpretation that it has anything to do with re-intermediating an insurance agent upon receiving a request to purchase an insurance policy according to a bindable insurance premium quotation and issuing the insurance policy. What is taught or suggested here is simply the traditional process of issuing an insurance policy — not the claimed invention's method for providing an insurance policy via a distributed computing network.

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But there is more. The Examiner has yet further argued that the system of Mitcham teaches the re-intermediating feature of the claimed invention at Col. 4, lines 16-17 and 22-25. This cannot be correct. Mitcham discusses that "[a]ny number of insurance companies or agents may supply rates to kiosk 12." Supplying rates to the kiosk in the system of Mitcham so that the kiosk can display these rates to the user is not the same as re-intermediating an insurance agent upon a request to purchase an insurance policy according to a bindable insurance premium quotation and then issuing the insurance policy.

Appellants have also pointed out the following: The Examiner has yet further argued that the system of Mitcham teaches the re-intermediating feature of the claimed invention at Col. 6, lines 19-24. This cannot be correct. As discussed above, this portion discusses the presentation of parallel options for a user to select. The user can select either completing an insurance contract or having a representative of an insurance company contact the user. However, that is completely different from the claimed invention, which recites "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation; and in response to said request, re-intermediating an insurance agent and issuing said insurance policy."

Appellants have additionally pointed out the following: The Examiner has argued that the system of Mitcham teaches the re-intermediating feature of the claimed invention at Col. 8, lines 31-36. This cannot be correct. This portion of Mitcham describes block 318 of a process illustrated by FIGURE 3D of Mitcham. Again, the logic flow of block 318 is in parallel to block 250 which allows a user to complete an insurance contract. No "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation; and in response to said request, re-intermediating an insurance agent and issuing said insurance policy" is taught or suggested by Mitcham at this portion.

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Finally, the Examiner has argued that the system of Mitcham teaches the re-intermediating feature of the claimed invention at Col. 9, line 20, through Col. 10, line 8. This cannot be correct. This portion of Mitcham happens to be Claim 1 of Mitcham. There is no teaching regarding re-intermediating an insurance agent. Mitcham does not expressly discuss or impliedly suggest the re-intermediating of an insurance agent after receiving a request to purchase an insurance policy according to a bindable insurance premium quotation and then issuing the insurance policy. (If the Examiner continues to have a different view, Appellants respectfully request that the Examiner point to the precise location in Claim 1 of Mitcham where Mitcham teaches re-intermediating an insurance agent.) Therefore, no *prima facie* case of anticipation has been established by the Examiner.

Clearly neither Mitcham, the CNA reference, or the MostChoice reference, alone much less in combination, teaches or suggests the subject matter of Claim 1. More specifically, none of these references, alone much less in combination, teaches or suggests "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy," as recited in Claim 1. As will be readily appreciated in the foregoing discussion, none of the three cited and applied references teaches or suggests the subject matter of Claim 1. As a result, Appellants submit that Claim 1 is clearly allowable in view of the teachings of the references.

With respect to Claims 3-7, all of which depend directly or indirectly from Claim 1, it is clear that the subject matter of these claims is also neither taught nor suggested by the cited and applied references, namely, Mitcham, the CNA reference, or the MostChoice reference. Claims 3-7 all have limitations that are clearly neither taught nor suggested by any of the cited and applied references, particularly when the limitations are considered in combination with these recitations of the claims from which these claims individually depend. For example, Claim

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3 recited the concept of transmitting an electronic version of said insurance policy to an individual insured by the said insurance policy. In summary, Claims 3-7 are submitted to be allowable for reasons in addition to the reasons why Claim 1 is submitted to be allowable.

Independent Claim 8 is directed to a system. Among other differences, none of the cited and applied references teaches the feature "receive a request to purchase said insurance policy according to said bindable insurance premium quotation, re-intermediating an insurance agent, and issuing said insurance policy," as recited in Claim 8. For generally the same reasons discussed above with respect to Claim 1, Appellants submit that the subject matter of Claim 8 is neither taught nor suggested by any of the cited and applied references, and thus, that Claim 8 is also allowable.

With respect to dependent Claims 10-18, all of which depend directly or indirectly from Claim 8, it is also clear that the subject matter of these claims is neither taught nor suggested by the cited and applied references, namely, Mitcham, the CNA reference, or the MostChoice reference. Claims 10-18 all have limitations that are clearly neither taught nor suggested by any of the cited and applied references, particularly when the limitations are considered in combination with these recitations of the claims from which these claims individually depend. In summary, Claims 10-18 are submitted to be allowable for reasons in addition to the reasons why Claim 8 is submitted to be allowable.

Independent Claim 19 is directed to a computer-readable medium. In many ways, the subject matter of independent Claim 19 mirrors the subject matter of the system recited in Claim 8 and the method recited in Claim 1, albeit in a different manner. For reasons generally similar to reasons discussed above with respect to Claims 1, 3, 4, 5, 6, and 7, Claim 19 is submitted to recite subject matter that is clearly neither taught nor suggested by any of the cited and applied references. Specifically, none of the cited and applied references teaches or even

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suggests "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy," as recited in Claim 1. As a result, Appellants respectfully submit that Claim 19 is allowable.

In light of the foregoing remarks, it is clear that none of the cited and applied references teaches, let alone renders unpatentable, the claimed inventions recited in Claims 1, 3-8, and 10-19. The cited and applied references are all directed to either having a user directly contact an insurance representative without re-intermediating or having the user apply for an on-line quotation that is not a bindable premium quotation; work in an entirely different manner from the present invention; or have nothing to do with the present invention. The present invention is directed to an entirely different concept and solution. The present application is directed to "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy.

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CONCLUSION

In view of the foregoing remarks, applicant submits that all of the claims in the present application are clearly patentably distinguishable over the teachings of Mitcham, the CNA reference, and the MostChoice reference, taken alone or in combination. Thus, applicants submit that this application is in condition for allowance. Reconsideration and reexamination of the application, allowance of the claims, and passing of the application to issue at an early date are solicited. If the Examiner has any remaining questions concerning this application, the Examiner is invited to contact the applicants' assigned attorney at the number below.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

Date: August 11, 2004 

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